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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,665	11/17/2000	Michael William Urbanski	057234-0101	4398

22428 7590 07/07/2005

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT PAPER NUMBER

3622

DATE MAILED: 07/07/2005

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**GROUP 3600**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/714,665  
Filing Date: November 17, 2000  
Appellant(s): URBANSKI ET AL.

Aaron C. Chatterjee, Esq.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 16 May 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

Appellant makes no statement, however, no amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is deficient. 37 CFR 41.37(c)(1)(v) requires the summary of claimed subject matter to include: (1) a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters and (2) for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The brief is deficient because, at lines 1-2 of the third para., it misstates the disclosure by stating that "an information site represents a computer server". The disclosure is as follows.

"A user first accesses a computer server (or more generically an 'information site') on a public or private network, such as the Internet." (Spec. p. 5 lines 20-21)

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It is disclosed that "information site" is a genus including "computer server", but there is no disclosure that "an information site represents a computer server". The interpretation of "information site" is at issue and discussed further below at (10), Response to Argument.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is materially correct, although the parenthetical identifiers are not those required by 37 CFR § 1.121(c). Claims 1, 16, 31-33 and 34-39 should have been labeled (Previously presented). Claims 2-15 and 17-30 should have been labeled (Original).

**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Thibadeau et al., US005432542A, 11 July 1995

Wachob, US005155591A, 13 October 1992.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 14 September 2004.

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed with an amendment on 18 January 2004 have been fully considered but they are not persuasive. The arguments are addressed at para. 6-9 and 12 below.

***Claim Objections***

2. Claims 36-39 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

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dependent form, or rewrite the claim(s) in independent form. The claims add only ownership limitations, which are nonfunctional descriptive matter. See MPEP 2106.IV.B.1(b), first paragraph, and para. 9 below.

***Claim Rejections - 35 USC § 102 and 35 USC § 103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-13, 15-28, 30, 31, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Thibadeau et al.
6. Thibadeau et al. teaches (Independent claims 1, 16 and 31) a method of and a system for displaying location based information from an information site on a network, a computer readable data storage medium having a programmable code of the method thereon, the method comprising: determining, at the information site, location data of a user of the location based information (col. 4 lines 31-36 and 44-47); generating, at the information site, location based information based on the determined location data of the user, and providing the generated location based information to the user over the network (col. 5 line 58 to col. 6 line 10).
7. Interpretation of "at the information site". Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity,

deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

8. The instant application contains no such clear definition for the phrase "at the information site". In the instant case, the examiner is required to give the phrase "at the information site" its broadest reasonable interpretation, which the examiner judges to be any site where information is *generated* or *determined*. The reference teaches (col. 2<sup>1</sup> lines 52-56) that location-based information is *generated* (i.e., *originated*, Merriam-Webster's Online Dictionary) and *determined* (i.e., *fixed authoritatively*, Merriam-Webster's Online Dictionary) at a set top receiver, so that reads on the information site.
9. The limitation "wherein the step of generating location based information comprises providing information exclusively from respective sponsors in respective categories of information" is an ownership limitation, and was accordingly not given patentable weight. This limitation constitutes descriptive material that does not describe a functional interrelationship (MPEP 2106.IV.B.1(b) at pp. 2100-13 and 2100-14 revised May 2004).
10. Thibadeau et al. also teaches at the citations given above, and at col. 10 line 65, claims 2-8, 10, 12, 13, 15, 17-23, 25, 27, 28 and 30. Thibadeau et al. also teaches: claims 9 and 24 (col. 7 line 18); claims 11 and 26 (col. 5 lines 42-44); and claims 36-37 (col. 6 lines 4-7).
11. Claims 14 and 29 are rejected under 35 U.S.C. 103(a) as being obvious over Thibadeau et al. Thibadeau et al. does not teach the Internet. However, the reference does teach WANs (col. 7 line 19), of which the Internet is comprised. Because using a system of WANs, which reads on the Internet, would facilitate use of the system, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the Internet to the teachings of Thibadeau et al.
12. Claims 32-35 are rejected under 35 U.S.C. 103(a) as being obvious over Thibadeau et al. in view of Wachob (US005155591A). Thibadeau et al. does not teach determining

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<sup>1</sup> This is a typo: the teaching is at col. 3, lines 52-56.

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contextual information, other than location, of a user. Wachob teaches determining contextual information, other than location, of a user (col. 3 lines 4-9). Because Wachob teaches the use of this information for ad-targeting (col. 7 lines 29-33), and Thibadeau et al. teaches that the reference invention can be useful for targeted marketing (col. 6 lines 2-3), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Wachob to those of Thibadeau et al.

13. Claims 38-39 are rejected under 35 U.S.C. 103(a) as being obvious over Thibadeau et al. Thibadeau et al. does not teach an auction and highest-bid matching. Because these are common mechanisms used to promote sales, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add an auction and highest-bid matching to the teachings of Thibadeau et al.

#### **(10) Response to Argument**

**I. Argument for Claims 1-13, 15-28, 30, 31, 36 and 37 rejected under 35 U.S.C. 102(b) as being anticipated by Thibadeau et al., and claims 14, 29, 38 and 39 rejected under 35 U.S.C. 103(a) as being obvious over Thibadeau et al.**

Appellant's p. 4, first para., is a summary of the three independent claims 1, 16 and 31. The remaining three para. are a summary of Thibadeau et al. Appellant's argument against the rejection begins on p. 5.

The essential issue is the examiner's interpretation of "information site", which is para. 7 and 8 of the final rejection given above, and related terms such as "network" and "server device". In essence, the examiner found that the application does not contain a "clear definition" of the term "at the information site", so the examiner gave this term its broadest reasonable interpretation, in light of the specification, consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). On this basis, the examiner judged that the appropriate interpretation of "at the information site" is any site where information is generated or determined.

On p. 5, first para., appellant argues that that is not an appropriate interpretation because "the specification defines an information site as a 'computer server on a public or private network, such as the Internet.'" That is not correct. The relevant part of the disclosure is as follows.

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"A user first accesses a computer server (or more generically an 'information site') on a public or private network, such as the Internet." (Spec. p. 5 lines 20-21)

It is disclosed therein only that "information site" is a genus including "computer server". It is not disclosed that an information site necessarily is a computer server.

The pertinent part of the rejection (from para. 8 above) is as follows. (The typo for col. 3 has been corrected.) "The reference teaches (col. 3 lines 52-56) that location-based information is *generated* (i.e., *originated*, Merriam-Webster's Online Dictionary) and *determined* (i.e., *fixed authoritatively*, Merriam-Webster's Online Dictionary) at a set top receiver, so that reads on the information site."

Independent claim 31 is limited to a "server device", which required the examiner to interpret this term as well. Following the logic required by the MPEP, the examiner interpreted this as any device that serves information. The set top receiver taught by Thibadeau et al. (col. 3 lines 52-56) reads on a server device.

At the bottom para. of p. 5, applicant argues that "network" in the claims "refers to an electronic network such as the Internet, a VPN, a LAN, or a WAN", and goes on to argue that nowhere does Thibadeau et al. teach such networks. The use of "such as" makes clear that the disclosure is giving examples of networks, not giving a "clear definition" of network. In any event, Thibadeau et al. teaches an "information distribution network" (col. 12 lines 9-10) and "computer information networks" (col. 5 line 44), either of which are a reasonable interpretation of "network" as used in the claims.

## **II. Argument for Claims 32-35 rejected under 35 U.S.C. 103(a) as being obvious over Thibadeau et al. in view of Wachob**

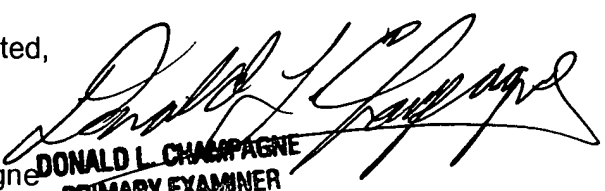
Appellant's argument is that the references do not teach or suggest "over a network" (actually "on a network" in independent claim 32). As noted above, Thibadeau et al. teaches an "information distribution network" (col. 12 lines 9-10) and "computer information networks" (col. 5 line 44), either of which are a reasonable interpretation of "network" as used in the claims.




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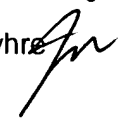
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

  
Donald L. Champagne  
Primary Examiner  
Art Unit 3622  
**DONALD L. CHAMPAGNE**  
**PRIMARY EXAMINER**

Conferees:

Jeffrey D. Carlson 

James W. Myhre 

5 July 2005